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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,266	11/30/2000	Steven L. Pratt	AUS9-2000-0486-US1	5203
3552S 7590 03/21/2007 IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER LEE, PHILIP C	
			ART UNIT 2152	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
2 MONTHS			03/21/2007	
			DELIVERY MODE PAPER	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/726,266  
Filing Date: November 30, 2000  
Appellant(s): PRATT ET AL.

**MAILED**

**MAR 21 2007**

**Technology Center 2100**

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Steven Pratt  
Dennis Riddlemoser  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed 11/30/2006 appealing from the Office action mailed 4/3/2006.

**(1) *Real Party in Interest***

A statement identifying by name the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) *Status of Claims***

The statement of the status of claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Claimed Subject Matter***

The summary of claimed subject matter contained in the brief is correct.

**(6) *Grounds of Rejection to be Reviewed on Appeal***

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) *Claims Appendix***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) *Evidence Relied Upon***

20020010768	MARKS et al	1-2002
6,161,139	Win et al	12-2000
5,781,738	Corn et al	7-1998
5,805,803	Birrell et al	9-1998

**(9) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

*Claim Rejections – 35 USC 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 18 claimed a computer program product stored in a computer-readable medium, and the specification defined the computer-readable medium as a transmission type media (signal or transmittal wave) (spec, page 11, lines 14-32). Thus, a

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computer program product stored on a transmission type media is not one of the categories of statutory subject matter.

*Claim Rejections - 35 USC 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 3, 5, 18-19 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Marks et al, U.S. Patent Application Publication 20020010768 (hereinafter Marks).

3. As per claims 1, 18 and 27, Marks taught the invention as claimed comprising:

creating a particular configuration file (user profile) for each user of a network, wherein each configuration file contains a list of the network resources that a user may access (page 4, paragraph 47);

receiving a user identification at a client (page 4, paragraph 45);

initiating a resource attachment program in response to receiving the user identification (page 4, paragraphs 46 and 47) (i.e., the middleware server queries the user database to determine a user profile for the user in response to receiving the user identification);

matching, using the resource attachment program, the user identification with a configuration file associated with the user identification (page 4, paragraph 47); and

attaching, using the resource attachment program, network resources to the client based on the list contained in the configuration file associated with the user identification (page 5, paragraph 51).

4. As per claim 3, Marks taught the invention as claimed in claim 1 above. Marks further taught wherein each configuration file is stored on a network server (database) (pages 2-3, paragraph 28; page 4, paragraph 47).

5. As per claims 5 and 19, Marks taught the invention as claimed in claims 1 and 18 above. Marks further taught wherein said resource attachment program is stored on the client computer (page 3, paragraph 30; page 5, paragraph 51)

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 6, 8-9, 15, 20 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks in view of Win et al, U.S. Patent 6,161,139 (hereinafter Win).

8. Win was cited in the last office action.

9. As per claims 2 and 15, Marks taught the invention as claimed in claims 1 and 18 above. Marks did not specifically teach the list is defined by a network administrator. Win taught wherein the list is defined by a network administrator (col. 12, lines 45-50).

10. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Marks and Win because Win's teaching of a network administrator defining the list would increase the administrator's flexibility in Marks's system by allowing administrator to control the assignment of resources to users (col. 12, lines 45-48).

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11. As per claims 6 and 20, Marks taught the invention as claimed in claims 1 and 18 above. Mark did not specifically teach said resource attachment program is stored on a server. Win taught wherein the resource attachment program is stored on a network server (fig. 7; col. 12, lines 51-53).

12. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Marks and Win for the same reason set forth in claim 2 above.

13. As per claims 8 and 22, Mark and Win taught the invention substantially as claimed in claims 7 and 21 above. Win further taught wherein the record is stored on the client (col. 13, lines 20-21; col. 23, lines 47-51).

14. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Marks and Win for the same reason set forth in claim 7 above.

15. As per claims 9 and 23, Marks and Win taught the invention substantially as claimed in claims 7 and 21 above. Win further taught wherein the record is stored on a network server (col. 13, lines 21-23).



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16. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Marks and Win for the same reason set forth in claim 7 above.

17. Claims 7, 10-11, 21, 24-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks and Win in view of Corn et al, U.S. Patent 5,781,738 (hereinafter Corn).

18. Corn was cited in the last office action.

19. As per claims 7 and 21, Marks taught the invention as claimed in claims 1 and 18 above. Mark did not teach creating a record of all successfully attached resources. Corn taught creating a record of all successfully attached resources (col. 3, line 46-col. 4, line 6).

20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Marks and Corn because Corn's teaching of creating a record of all successfully attached resources would increase the alertness of Marks's system by allowing the system to determine whether any programs or files (i.e. resources) are opened across the network (col. 4, lines 5-13).

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21. As per claims 10, 24 and 28, Marks taught the invention as claimed in claims 1, 18 and 27 above. Marks did not teach unattaching the resources when the user log out. Corn taught comprising:

receiving a log out command from the user and unattaching the attached resources (col. 3, lines 28-45).

22. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Marks and Corn because Corn's teaching of unattaching the resources would increase the efficiency of Marks's system by allowing the unattached resources to be shared with other user (col. 3, lines 32-33).

23. As per claims 11 and 25, Marks and Corn taught the invention substantially as claimed in claims 7 and 21 above. Corn further taught comprising:

receiving a log out command from the user and deleting the record of attached resources (col. 7, lines 33-39; col. 5, lines 64-col. 6, lines 4).

24. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Marks and Corn for the same reason set forth in claim 7 above.

25. Claims 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Win in view of Birrell, U.S. Patent 6,805,803 (hereinafter Birrell).

26. Birrell was cited in the last office action.

27. As per claims 12 and 26, Marks taught the invention as claimed in claims 1 and 18 above. Marks did not teach the client computer uses the UNIX operating system. Birrell taught wherein the client computer uses the UNIX operating system (col. 15, lines 23-32).

28. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Marks and Birrell because Birrell's teaching of using the UNIX operating system would increase the flexibility of Marks's system by allowing the use of client with different type of operating system according to the choice of the designer.

**(10) Response to Argument**

The examiner summarizes the various points raised by the appellant and addresses replies individually.

Appellant argued that:

- (1) Claim 18 is statutory.
- (2) Marks does not teach creating a particular configuration file for each user of a network.
- (3) Marks does not teach features of matching and attaching using the same resource attachment program.

- (4) No proper teaching, suggestion, or motivation to combine the references of Marks with Win.
- (5) No teaching, suggestion, or motivation exists to combine the references of Marks and Win because each reference of Marks and Win represents a complete solution to the problem that each solve.
- (6) No motivation exists to combine Marks and Corn because they address different.
- (7) No motivation exists to combine Win and Birrell because they address different.

**In reply** to argument (1): claim 18 claims “a computer program product stored in a computer-readable medium”, which is intended to include non-statutory subject matter. Specifically, according to page 11, lines 14-32 of the specification, it is clear from the examples of a computer readable media such as transmission-type media, radio frequency and light wave transmissions (i.e., signal per se) that applicant is intended to include signal and carrier wave as the claimed computer-readable medium. Although “signal” or “carrier waves” are not explicitly cited in claim 18, however, the scope of a computer-readable medium covers non-statutory subject matter of a “signal” or “carrier waves” in light of the specification. Accordingly, “a computer program product stored in a computer-readable medium” is merely a signal per se, which is ineligible for patent protection because of it does not fall within any of the four statutory classes under 35 USC 101.

**In reply** to argument (2): It is conventional in the art that each user of an enterprise have different privileges based on identity of each user. For example, an examiner will have different privileges than a Supervisor in Patent Office. The Supervisor can have access to production report of every examiner in the unit while an examiner will not. Every computer user of Patent Office must have a configuration file created for identifying every computer user as an examiner or a Supervisor. Based on the user login to the Patent Office, the network of Patent Office must match user login information with the configuration file created in order to allocate privileges to the user as an examiner or a supervisor. This is conventionally known and accepted in the art. This conventional method is described in the cited prior art of Marks. Specifically, Marks teaches user login is granted based on user id and password. A middleware server in network operations center (NOC) queries the user database to determine a user profile for the user. The user profile include user privileges (e.g., allow/deny URL list) ([0045], [0046]). Marks further teach user privileges was predetermined [0042]. Evidently, Marks system inherently creates a user profile (i.e., configuration file) and stores in the database prior to user login. Since user profile include user privileges that are based on user identity [0006], a user profile must be created for each user of a network in order for the user profile to be retrieved from the database upon user login.

**In reply** to argument (3): Marks teaches network operations center (NOC) include servers, which are software (i.e., program) [0025] that provide access to resource (i.e., servers that allocate resources, [0023]). Specifically, server such as middleware server in the NOC queries user profile that includes privileges, and access to resource (e.g., allow/deny URL list) based on the user identity from the database and provides the access to resource ([0047], [0023]).

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This means that the privileges and access to resource are allocated or provided to the client by the NOC. Therefore, Marks discloses server that determines matching user identification to a user profile and attaching the privileges and access to the client. Examiner interprets attaching network resources to client as allocating or providing network resource to client.

**In reply** to argument (4): as stated in page 20, paragraph 2 of the appeal brief, appellant reasons that Marks's system is designed to automatically create user profile upon user login, and combine with Win will require the system administrator in Marks manually define the user profile itself. Adjusting the user profile itself would be labor intensive and inefficient. For this reason, no proper teaching, suggestion, or motivation to combine the references of Marks with Win. As explained in reply to argument (1), user profile must be created prior to user login. The combination of Win's teaching with Marks would require a system administrator to create user profile with privileges and access to resources and store the user profile in the database in order for querying by the NOC. One having ordinary skill in the art at the time of the invention was made would be motivated to combine the teachings of Marks and Win because Win's teaching of a network administrator defining the list would increase the administrator's flexibility in Marks's system by allowing administrator to control the assignment of resources to users (col. 12, lines 45-48).

**In reply** to argument (5): In response to applicant's argument that Win is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references of

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Marks and Win are in the field of management of resource by access control (see Marks, ([0001],[0005],[0006])); see Win, (col. 1, line 22-24; col. 5, lines 45-49)), therefore one having ordinary skill in the art at the time of the invention was made would be motivated to combine the teachings of Marks and Win because Win's teaching of a network administrator defining the list would increase the administrator's flexibility in Marks's system by allowing administrator to control the assignment of resources to users (col. 12, lines 45-48).

**In reply** to argument (6): In response to applicant's argument that Corn is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Marks is in the field of management of resources by controlling access and providing the resources to user ([0001],[0005],[0006]), and Win is directed to management of resources by releasing resource assigned to user upon logoff (col. 3, lines 27-33). Hence, both references of Marks and Corn are in the field of management of resources.

**In reply** to argument (7): In response to applicant's argument that Birrell is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references of Win and Birrell are in the field of management of resource. Win is directed to management of resource upon logoff of a user (col. 1, line 22-24; col. 5, lines 45-49), and Birrell is directed to

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management of resource by providing secure access to private intranet resources via a public network (abstract; col. 3, lines 6-7).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

**(12) Conclusion**

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Philip Lee

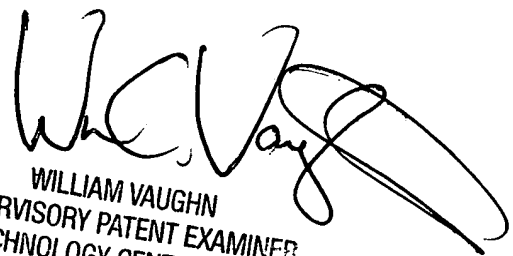
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